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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------|------------------|
| 10/663,509      | 09/16/2003  | Ronald P. Doyle      | RSW920030124US1 (112) | 1867             |

46320 7590 04/28/2009  
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| EXAMINER |
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ANTONIENKO, DEBRA L

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| ART UNIT | PAPER NUMBER |
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3689

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| MAIL DATE | DELIVERY MODE |
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04/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/663,509

Applicant(s)

DOYLE ET AL.

Examiner

DEBRA ANTONIENKO

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,9,13 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9,13 and 17-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 12, 2009 has been entered.

2. This is a Non-Final Office Action in response to communications received February 12, 2009, wherein:

Claims 1, 9, and 13 have been amended;

Claims 2-8, 10-12, and 14-16 have been cancelled;

Claims 17-28 have been newly added; and

Claims 1, 9, 13, and 17-28 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed limitations of "a pervasive device" and "a personal article" are vague and indefinite.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 9 and 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. With respect to being tied to another statutory class, a particular machine must impose meaningful limits on the method claim's scope. The machine must be positively recited in the body of the claim showing its significant function in the invention. Therefore, the language of independent Claim 9 does not include the required tie or transformation and thus is directed to nonstatutory subject matter. Claims 23-25 are dependent and are rejected in a like manner.

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**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1, 17, 18, 20, and 21** are rejected under 35 U.S.C. 102(b) as being anticipated by Pitroda, U.S. Patent Number 5,884,271 (hereinafter referred to as Pitroda).

Regarding Claim 1, Pitroda teaches a receipt management article of manufacture comprising: a computer storage medium configured to store receipt data from multiple disparate vendors (column 10, lines 4-32); communications logic for establishing a communicative link between the system and receipt data processing logic disposed within individual ones of said multiple disparate vendors (column 10, lines 26-39); and a receipt management processor programmed to moderate access to said store receipt data in said storage medium to an individual one of said multiple disparate vendors, wherein said storage medium further comprises a configuration for indexing said store

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receipt data according to at least one of a vendor identifier and a transaction identifier (column 12, line 21 – column 13, line 15).

Regarding Claim 17, Pitroda further teaches wherein said storage medium comprises a portable mass storage device (Figure 3).

Regarding Claim 18, Pitroda further teaches wherein said communicative link comprises a wireless link (column 10, lines 4-39).

Regarding Claim 20, Pitroda further teaches wherein each of said storage medium, communications logic and receipt management processor is disposed in a pervasive device (column 9, lines 49-63).

Regarding Claim 21, Pitroda further teaches wherein each of said storage medium, communications logic and receipt management processor is disposed in a personal article (column 9, lines 49-63).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda, U.S. Patent Number 5,884,271 (hereinafter Pitroda).

Regarding Claim 19, Pitroda does not explicitly teach security and authentication logic programmed to secure access to said receipt data through at least one of encryption, password protection and certificate validation and authentication. However, Pitroda teaches that the *UET card also includes security means... for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction card* (column 4, lines 10-14). Also, Pitroda teaches *access to information stored in the card... can be blocked, unless the proper authorization code is entered* (column 14, lines 7-18). Therefore, it is obvious to one of ordinary skill in the art at the time of the invention that an authorization code or password is used to access information.

11. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Bam et al., U.S. Patent Application Publication Number 2004/0083170 A1 (hereinafter Bam).

Regarding Claim 22, Pitroda does not explicitly teach wherein said personal article comprises a key chain fob. However, Bam discloses that the *wallet now carries different pieces of information and service provider information, such as identification cards, payment cards... Key chains are also being used to carry tags containing these*

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*pieces of information* ([0006]). Also, Bam discloses *the system offers... digital receipt management* ([0027]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Bam to allow for a key chain hook in order to provide convenience to the consumer.

12. **Claims 9, 13, 23, 25, 26, and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Steele et al., U.S. Patent Number 7,016,877 B1 (hereinafter Steele).

Regarding Claims 9 and 13, Pitroda teaches a method and computer-readable instructions, respectively, for electronic receipt management comprising the steps of: establishing a communicative link between a data store of electronic receipts from multiple disparate vendors, and an individual one of said multiple disparate vendors (column 10, lines 4-39).

Pitroda does not explicitly teach locating a specific electronic receipt stored within said data store which corresponds to an identifier provided by said individual one of said multiple disparate vendors. However, Pitroda teaches *a transaction memory 410 is provided to store all transaction receipts in electronic form to eliminate or reduce paper receipts... database management 414... POS ID numbers... sales identifications* (column 12, lines 21-32 and lines 60-67; Figure 2). It is old and well-known that receipts have identification numbers given by the vendors as the vendors have their own accounting. Therefore, it would have been obvious to one of ordinary skill in the art at



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the time of the invention to locate receipts by vendor identifier in order to maintain consistency.

Pitroda does not explicitly teach transmitting said located specific electronic receipt to said individual one of said multiple disparate vendors over said established communicative link. However, Pitroda discloses that the CIU can read information from the UET card and that the *CIU unit may include an interface for a point of sale computer* (column 13, lines 1-16; Figure 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit a receipt to the vendor if needed.

Pitroda does not teach authenticating said individual one of said multiple disparate vendors. However, Steele discloses vender authentication (column 16, line 46 – column 17, line 18). Pitroda teaches that the *UET card also includes security means... for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction card* (column 4, lines 10-14). Also, Pitroda teaches *access to information stored in the card... can be blocked, unless the proper authorization code is entered* (column 14, lines 7-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Steele to include vendor authentication in order to prevent unauthorized access to the stored information.

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Regarding Claims 23 and 26, Pitroda further teaches wherein said establishing step comprises the step of configuring a wireless communications link with said individual one of said multiple disparate vendors (column 10, lines 4-39).

Regarding Claims 25 and 28, Pitroda further teaches wherein said establishing step comprises the step of inserting a portable storage medium containing said data store into a reader coupled to said individual one of said multiple disparate vendors (column 10, lines 4-39).

13. **Claims 24 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Smith et al., U.S. Patent Number 6,487,540 B1 (hereinafter Smith).

Regarding Claims 24 and 27, Pitroda does not teach wherein said establishing step comprises the step of configuring a wirebound communications link with said individual one of said multiple disparate vendors. However, Smith discloses that a *receipt is transferred from the vendor to the WPD via a wired or wireless Internet connection* (column 3, lines 63-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Smith to include wired connection as well in order to provide convenience to the customer.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
4/27/09